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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,938	05/26/2000	Timothy J Williams	TJW-00100	8295
28960	7590	03/15/2005	EXAMINER	
HAVERSTOCK & OWENS LLP			SORKIN, DAVID L	
162 NORTH WOLFE ROAD			ART UNIT	
SUNNYVALE, CA 94086			PAPER NUMBER	

1723

DATE MAILED: 03/15/2005

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY-DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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205

DATE MAILED:

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Commissioner for Patents

David L. Sorkin
Primary Examiner
Art Unit: 1723



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/579,938
Filing Date: May 26, 2000
Appellant: WILLIAMS, TIMOTHY J

MAILED
MAR 15 2005
GROUP 1700

Jonathan O. Owens
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 December 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct, but the Examiner repeats the status here for clarity:

Claims 1, 3-7, 9-11 and 13-34 are pending.

Claims 2, 8 and 12 are canceled.

Claims 20 and 27 are allowed.

Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 are rejected.

Claims 1, 3-7, 9-11, 13-19, 21-26 and 28-34 are appealed.

(4) *Status of Amendments*

No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The summary of the claimed subject matter contained in the brief is correct.

On page 3, lines 14-18 of the brief the limitation in independent claim 1, "means for dispensing" is discussed with respect to structure described in the specification, although the term "corresponding structure" is not used, and section 112 sixth paragraph is not explicitly mentioned.

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(6) *Grounds of Rejections to be Reviewed on Appeal*

The appellant's statement of the grounds for rejection to be reviewed was correct at the time the brief was filed; however, subsequent to an appeal conference, the rejection of claims 29-33 under the second paragraph of section 112 is no longer maintained. All other grounds for rejection, including rejection of claims 29-33 under the first paragraph of section 112 are maintained.

(7) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

US 5,842,606	DeVito	12-1998
US 6,109,482	Briggs	08-2000
US 2,848,019	Corbin et al.	08-1958
US 4,311,017	Reed et al.	01-1982
US 5,899,362	Moran	05-1999

"Cole-Palmer's Food TechSource" 2002.

Note: Moran (US 5,899,362) and "Cole-Palmer's Food TechSource" are cited as factual references only, and not as prior art references.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. These claims recite the limitation "the dispensing mechanism has a size sufficient for paint to flow through". However, the issue of the size of the dispensing mechanism is simply not discussed in the originally filed specification at all.

Claim Rejections - 35 USC § 102

Claims 1, 3, 4 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by DeVito (US 5,842,606). Regarding claim 1, DeVito ('606) discloses a container comprising a plurality of compartments (a plurality of 34) having a front, a back, a first side, a second side and a base; a frame (a plurality of 12 joined together as disclosed) holding the compartments; and means (52) for dispensing removably coupled to the base of the compartments, wherein the means for dispensing is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also *In re Schreiber*, 44 USPQ2d 1429, 1931 (Fed. Cir. 1997), where a claimed popcorn dispensing spout was held anticipated by a spout for dispensing oil from an oil can. The container of DeVito ('606) is intended to hold liquids (see col. 1, lines 6-8) and clearly would be capable of holding and dispensing paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 5). Regarding claim 4, the frame includes mounting slots (38). Regarding claim 29, a structure which dispenses beverages would be capable of dispensing paint, because the term "paint"

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includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively.

Claims 1, 3, 4 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Briggs (US 6,109,482). Regarding claim 1, Briggs ('482) discloses an container comprising a plurality of compartments (see Fig. 5) having a front, back, first and second side and base; a frame (a plurality of 12 joined together as shown in Fig. 2) holding the compartments; and means (22) for dispensing removably coupled to the base of the compartments for dispensing from the compartments, wherein the means for dispensing is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. See also *In re Schreiber*, supra., where a claimed popcorn dispensing spout was held anticipated by a spout for dispensing oil from an oil can. The container of Briggs ('482) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding and dispensing paint.

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Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 3). Regarding claim 4, the frame includes mounting slots (42). Regarding claim 29, a structure which dispenses beverages would be capable of dispensing paint, because the term "paint" includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively. Note also the dispensing mechanism of Briggs ('482) is so big that it fits around the neck of a 2-liter soda bottle (see col. 4 lines 14-18).

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Corbin et al. (US 2,848,019) discloses a paint storage container comprising one or more colors of paint (see col. 9, lines 66-73); a plurality of paint storage compartments (24) each for storing a color paint, each paint storage compartment having a front, a back, a first side, a second side and a base (see Figs. 1, 4 and 15); a frame (20,22) holding the paint storage compartments; and a dispensing mechanism (43,33) coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments, wherein the dispensing mechanism is capable of dispensing paint without lifting the paint compartments (see col. 3 line 21 to col. 4 line 2).

Claim Rejections - 35 USC § 103

Claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017). Regarding claim 1, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; and means (15,16) for dispensing coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 3, the dispensing means is a spigot assembly (see col. 5, lines 11-37). Regarding claim 4, the frame includes slots (101'). Regarding claim 5, one or more removable lids (25, 26 and/or 3) selectively cover the paint compartments, and means for stirring (111,112,113,114) are removably coupled to the lids. Regarding claim 6, the stirring means further comprises a circular

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base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 7, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a planar first side and a planar second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; lids (25,26 and/or 3); a stirring assembly (111,112,113,114) removably coupled to the lid(s); and a dispensing mechanism (15,16) coupled to the base. The dispensing mechanism is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 9, the frame includes slots (101'). Regarding claim 10, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts

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removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 11, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; a dispensing mechanism (15,16), one or more removable lids (25, 26 and/or 3) covering the compartments; and a stirring assembly (111,112,113,114) removably coupled to the lids. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra.

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 13, the dispensing mechanism includes a spigot assembly (see col. 5, lines 11-37). Regarding claim 14, the frame includes slots (101'). Regarding claim 15, the stirring assembly further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the

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rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 16, Reed ('017) discloses a reusable container comprising a plurality of compartments (24,27) each having a first front, a first back, a first side, a second side and a base; body (2) holding the paint compartments having a second front, a second back, a planar third side and a planar fourth side (see Fig. 1); one or more removable lids (25, 26 and/or 3) coupled to the paint compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids; a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids; and a dispensing mechanism (15,16) coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it

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is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 17, the body includes slots (101'). Regarding claim 18, the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 19, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claim 22, Reed ('017) discloses a reusable container comprising a body (2) having a first side and a second side and a plurality of compartments (24,27) each having a front, a back, a planar first side, a planar second side and a base; one or more removable lids (25, 26 and/or 3) coupled to the compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids extending into a corresponding compartment; a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids; and a dispensing mechanism (15,16) coupled to the base. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, *supra*. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* *supra*. The container of Reed ('017) is

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intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). See also *In re Larson*, 144 USPQ 347, 349 (CCPA 1965) regarding the obviousness of making part integral. Regarding claim 23, the paint compartments are single walled (see Fig. 5). Regarding claim 24, the body includes slots (101'). Regarding claim 25 the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 26, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claims 29-33 a structure which dispenses beverages would be capable of dispensing paint, because the term "paint" includes liquids of similar consistency to common beverages. Applicant argues that a dispensing mechanism which allows paint to flow is necessarily bigger than the size of a beverage dispensing mechanism. Contrary to applicant's arguments, paint may be in the same viscosity range as beverages. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24), while Cole-Palmer's Food TechSource discloses that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively. The dispensing mechanism of Reed ('017) is shown in Figs. 1 and 3 and described in col. 5, lines 11-37.

Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017) in view of Briggs (US 6,109,482). The apparatus of Reed ('017), discussed above regarding claims 16 and 22, fails to include rounded ribs and channels. Briggs ('482) discloses rounded ribs (44) and channels/grooves (42). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Reed ('017) with ribs and channels/grooves as taught by Briggs ('482), because Briggs ('482) states that such ribs and grooves provided the benefit of allowing removable side-by-side coupling of a plurality of unit apparatuses (see col. 5. lines 13-32).

(10) *Response to Argument*

Rejection of claims 29-33 under section 112, first paragraph as failing to comply with the description requirement.

The originally filed application provides absolutely no information concerning the size of the dispensing mechanism. Nothing in the original disclosure would have conveyed to one skilled in the art that size of the dispensing mechanism was an aspect of any invention described in the application. The original disclosure does not describe a relationship between the size of a dispensing mechanism and a capability of a dispensing mechanism to dispense paint. Appellant has not established an intrinsic threshold size below which a dispensing mechanism necessarily could not dispense paint. Oppositely, friction forces between a fluid and the surfaces defining an orifice are not infinite. While such forces may prevent flow of a particular fluid at a particular pressure (including hydrostatic pressure of the fluid above the orifice), a sufficient

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pressure difference across the orifice will overcome the finite friction force. For example, in a container with an orifice at the bottom, flow of a particular fluid may not occur when there is only one millimeter of fluid in the container, but may occur when there is 20 centimeters of fluid in the container, because hydrostatic pressure is 200 times greater. In summary, the specification provides absolutely no information concerning the size of the dispensing mechanism, does not even remotely suggest that size of the dispensing mechanism is an aspect of the invention, and appellant does not establish any intrinsic relationship between the ability to dispense paint and a threshold size for a dispensing mechanism.

Furthermore, the respective parent claims of 29-33 already require that the dispensing mechanism be capable of dispensing paint. If claims 29-33 are construed as further limiting their respective parent claims, such a further limitation to a particular size is certainly not described in the original application.

Rejection of claims 1, 3, 4 and 29 under section 102(b) as anticipated by DeVito (US 5,842,606).

On page 7 of the brief, it is stated under the heading "Generally The References Applied Are Directed to Non Analogous Art" that "Most of the references cited within the Office Action are directed to beverage containers". While the examiner considers that the problem of dispensing paint involves primarily the same issues as dispensing beverages, as held in *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 213 USPQ 1, 7 (CCPA 1982)), "Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not

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recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102".

In the same paragraph applicant quotes *Emergency Fuel, LLC v. Pennzoil-Quaker State Co.* as stating "...new methods may be patentable..."; however, none of the appealed claims are method claims.

Despite the fact that claims 1, 3, 4 and 29 are apparatus claims, and that "paint" is not an element of the claimed structure for any of claims 1, 3, 4 and 29, appellant argues that the expressions concerning "paint" recited in the claims distinguish the claims over the prior art. Particularly, appellant argues on page 8 of the brief "Paint, specifically house paint, is typically between 3,000-6,000 centipoise and sometimes upwards of 20,000 centipoise", hence it is obvious that its viscosity will not permit it to flow through a small opening that liquids like milk or even tomato juice could flow through". However, firstly, none of the claims requires a capability to dispense "house" paint. A capability to dispense a paint which is not "house" paint would satisfy the claim limitations. Paint may have a viscosity much lower than 3000 centipoise. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24). This is between the viscosity of milk and cream and much less than that of tomato juice (see Cole-Palmer's Food TechSource). That the prior art apparatus be capable of dispensing something which is paint is sufficient to satisfy the claims. The prior art apparatus does not need to be capable of dispensing a particular type of paint such as "house paint", to anticipate the claims. The prior art apparatus need not be capable of dispensing a particular house paint advertised on EBAY as having a

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viscosity which is four times that of mayonnaise to anticipate the claim. Given that in *In re Schreiber, supra*, the Federal Circuit affirmed that an oil dispensing spout would be capable of dispensing popped popcorn, the determination that the apparatus of DeVito would be capable of dispensing paint is entirely proper. Secondly, while applicant has submitted evidence concerning the viscosities of paints, appellant's assertion that "paint will not flow through just any size opening" is not supported by evidence or reasoning. As held in *In re Schulze*, 145 USPQ 716, 718 (CCPA 1965), "[a]rgument in the brief does not take the place of evidence in the record". Furthermore, as held in *In re Geisler*, 43 USPQ2d 1362 (Fed. Cir. 1997), "[a]n assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case". Opposite of appellant's assertion, the examiner considers that given enough pressure, a fluid will flow through any size opening, and given no pressure difference across an orifice, no flow will occur (see Moran US 5,899,382 col. 5 line 58 to col. 6 line 5). To say that there is some opening so small that no pressure is sufficient to cause flow, is to say that friction forces are infinite, which is clearly impossible.

Appellant argues that the dispensing means of Devito is not removably coupled to the base of the compartments, however, Devito expressly states in col. 7 lines 37-42: "The nozzle 52 is removed by turning it in a counterclockwise direction to disengage the thread 56".

Rejection of claims 1, 3, 4 and 29 under section 102(e) as anticipated by Briggs (US 6,109,482).

On page 7 of the brief, it is stated under the heading "Generally The References Applied Are Directed to Non Analogous Art" that "Most of the references cited within the Office Action are directed to beverage containers". While the examiner considers that the problem of dispensing paint involves primarily the same issues as dispensing beverages, as held in *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 213 USPQ 1, 7 (CCPA 1982)), "Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under section 102".

In the same paragraph applicant quotes *Emergency Fuel, LLC v. Pennzoil-Quaker State Co.* as stating "...new methods may be patentable..."; however, none of the appealed claims are method claims.

Despite the fact that claims 1, 3, 4 and 29 are apparatus claims, and that "paint" is not an element of the claimed structure for any of claims 1, 3, 4 and 29, appellant argues that the expressions concerning "paint" recited in the claims distinguish the claims over the prior art. Particularly, appellant argues on page 11 of the brief "Paint, specifically house paint, is typically between 3,000-6,000 centipoise and sometimes upwards of 20,000 centipoise", hence it is obvious that its viscosity will not permit it to flow through a small opening that liquids like milk or even tomato juice could flow through". However, firstly, none of the claims requires a capability to dispense "house" paint. A capability to dispense a paint which is not "house" paint would satisfy the claim limitations. Paint may have a viscosity much lower than 3000 centipoise. For example

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Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24). This is between the viscosity of milk and cream and much less than that of tomato juice (see Cole-Palmer's Food TechSource). That the prior art apparatus be capable of dispensing something which is paint is sufficient to satisfy the claims. The prior art apparatus does not need to be capable of dispensing a particular type of paint such as "house paint", to anticipate the claims. The prior art apparatus need not be capable of dispensing a particular house paint advertised on EBAY as having a viscosity which is four times that of mayonnaise to anticipate the claim. Given that in *In re Schreiber, supra*, the Federal Circuit affirmed that an oil dispensing spout would be capable of dispensing popped popcorn, the determination that the apparatus of Briggs would be capable of dispensing paint is entirely proper. Secondly, while applicant has submitted evidence concerning the viscosities of paints, appellant's assertion that "paint will not flow through just any size opening" is not supported by evidence or reasoning. As held in *In re Schulze*, 145 USPQ 716, 718 (CCPA 1965), "[a]rgument in the brief does not take the place of evidence in the record". Furthermore, as held in *In re Geisler*, 43 USPQ2d 1362 (Fed. Cir. 1997), "[a]n assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case". Opposite of appellant's assertion, the examiner considers that given enough pressure, a fluid will flow through any size opening, and given no pressure difference across an orifice, no flow will occur (see Moran US 5,899,382 col. 5 line 58 to col. 6 line 5). To say that there is some opening so small that

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no pressure is sufficient to cause flow, is to say that friction forces are infinite, which is clearly impossible.

Appellant argues that the dispensing means of Briggs is not removably coupled to the base of the compartments, however "threaded recess 16" provides a removable coupling for the dispensing means, which makes it removable from the base of the compartment (the compartment being the bottle depicted in Fig. 5).

Rejection of claim 34 under section 102(b) as anticipated by Corbin et al. (US 2,848,018)

Unlike any other of the claims, claim 34 requires "paint" as part of the claimed product. Correspondingly, Corbin explicitly discloses paint (see title, col. 1, lines 15-21).

Applicant alleges that Corbin et al. (US 2,848,019) "does not teach storage compartments for storing paint" (page 13 of the brief). Corbin ('019) expressly states in col. 1 lines 30-33, "a plurality of liquids are available in individual storage reservoirs" and makes overwhelmingly clear that the liquids are paint, expressly stating in column 25 lines 48-50 (i.e. claim 35), "Paint dispensing apparatus of the class described, comprising a plurality of reservoirs each adapted to hold a paint".

Rejection of claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 under section 103(a) as unpatentable over Reed et al. (US 4,311,017).

Reed ('017) is analogous art with respect to the claimed invention because both concern mixing and dispensing liquids. The claims of Reed ('017) use the generic term "liquid" and the invention of Reed ('017) should not be misconstrued as limited to a particular liquid. It should also be noted that in col. 6 lines 45-47, Reed ('017) mentions

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"stirring up sediment which may have settled to the bottom of a beverage or other liquid contained in container 24".

Despite the fact that claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33 are apparatus claims, and that "paint" is not an element of the claimed structure for any of claims 1, 3-7, 9-11, 13-19, 22-26 and 29-33, appellant argues that the expressions concerning "paint" recited in the claims distinguish the claims over the prior art. Particularly, appellant argues on page 14 of the brief "Paint, specifically house paint, is typically between 3,000-6,000 centipoise and sometimes upwards of 20,000 centipoise", hence it is obvious that its viscosity will not permit it to flow through a small opening that liquids like milk or even tomato juice could flow through". However, firstly, none of the claims requires a capability to dispense "house" paint. A capability to dispense a paint which is not "house" paint would satisfy the claim limitations. Paint may have a viscosity much lower than 3000 centipoise. For example Moran (US 5,899,362) discloses an example of paint having a viscosity of "7 centipoise" (col. 8 line 24). This is between the viscosity of milk and cream and much less than that of tomato juice (see Cole-Palmer's Food TechSource). That the prior art apparatus be capable of dispensing something which is paint is sufficient to satisfy the claims. The prior art apparatus does not need to be capable of dispensing a particular type of paint such as "house paint", to anticipate the claims. The prior art apparatus need not be capable of dispensing a particular house paint advertised on EBAY as having a viscosity which is four times that of mayonnaise to anticipate the claim. Given that in *In re Schreiber, supra*, the Federal Circuit affirmed that an oil dispensing spout would be capable of dispensing popped popcorn, the

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determination that the apparatus of Reed would be capable of dispensing paint is entirely proper. The discussion of "sediment" containing liquids in col. 6 lines 45-47 makes overwhelmingly clear that the dispensing mechanism would be capable of dispensing paint. Secondly, while applicant has submitted evidence concerning the viscosities of paints, appellant's assertion that "paint will not flow through just any size opening" is not supported by evidence or reasoning. As held in *In re Schulze*, 145 USPQ 716, 718 (CCPA 1965), "[a]rgument in the brief does not take the place of evidence in the record". Furthermore, as held in *In re Geisler*, 43 USPQ2d 1362 (Fed. Cir. 1997), "[a]n assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case". Opposite of appellant's assertion, the examiner considers that given enough pressure, a fluid will flow through any size opening, and given no pressure difference across an orifice, no flow will occur (see Moran US 5,899,382 col. 5 line 58 to col. 6 line 5). To say that there is some opening so small that no pressure is sufficient to cause flow, is to say that friction forces are infinite, which is clearly impossible.

The examiner acknowledges that Reed ('017) does not explicitly state that the dispensing means is removable (although Fig. 3 appears to depict a hex nut). Appellant does not address why or why not making this part removable would or would not have been obvious to one of ordinary skill in the art at the time of the invention.

Rejection of claims 21 and 28 under section 103(a) as unpatentable over Reed et al. (US 4,311,017) in view of Briggs (US 6,109,482).

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Appellant relies upon arguments for the parent claims' patentability with regard to these dependent claims. No further arguments are presented with regard to claims 21 and 28.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
Art Unit 1723

DLS

March 2, 2005

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